

## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 17, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 103(a)**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

**A. Rejection of Claims 11-13, 15, 19, 24, and 25**

Claims 11-13, 15, 24, and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein* (U.S. Pat. No. 5,809,167) and *Lo et al.* (“Lo,” U.S. Pat. No. 6,268,927). Applicant respectfully traverses this rejection.

**1. The Al-Hussein Disclosure**

Al-Hussein discloses a stand-alone “personal imaging computer system.” *Al-Hussein*, column 5, lines 6-10. As described by Al-Hussein, the system takes the form of PICS equipment 20, which essentially comprises a facsimile machine having the capabilities of a computer. *Al-Hussein*, column 5, lines 23-38.

Notably, Al-Hussein’s PICS equipment 20 is *not* described as performing the functions of a printer. Instead, Al-Hussein describes additional printers 45, 56, which serve that function.

**2. Applicant’s Claims**

**a. Claims 11-13 and 15**

Applicant’s claim 11 provides as follows (emphasis added):

11. A method practiced by a printer for printing a form, the method comprising:

*accessing form imaging data from at least one store via a network with the printer;*

*retrieving the form imaging data from the at least one store with the printer;*

merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form; and

*printing* the form imaging data along with the already stored static form data together as a hard copy form, such that printing a hard copy form is possible without the need to send the static form data to the printer and such that a copy of the static form data need only be stored on the printer.

As to claim 11, the Examiner states:

Regarding claim 11, Al-Hussein teaches a method practiced by a printing device for printing a document comprising the steps of accessing document imaging data from at least one store via a network with the printing device (Al-Hussein, col 6, ln 12-16, files are accessed from network disk. Additionally the actions are performed by the printer itself, which comprises a general purpose computer, col 5, ln 53-60. Thus any actions performed on any general purpose computer may be performed within the personal imaging computer system (PICS) of Al-Hussein), retrieving the document imaging data from the at least one store, and printing the document imaging data with the printing device (Al-Hussein, col 6, ln 22-25, method comprises retrieving the document image and associated text file and printing at a printer).

*Office Action*, pages 10-11.

As an initial matter, Applicant notes that Al-Hussein's PIC equipment 20 is not a "printer" and does not function as a printer. Instead, as described above, the equipment 20 comprises a facsimile machine that has characteristics of a computer. Although the equipment 20 can scan and fax documents as well as print received fax transmissions, Al-Hussein does not state that the equipment is used as a printer that, as is well known in the

art, receives print ready data from a computer (e.g., PC or print server), renders the data as an image, and prints the image. That Al-Hussein's equipment 20 does not comprise a printer or act in the capacity of a printer is underscored by the fact that Al-Hussein describes separate printers 45 and 56 that provide the printer functionality. *See Al-Hussein*, column 6, lines 16-25; column 6, lines 45-53; Fig. 4. Accordingly, Al-Hussein's equipment 20 is not a printer as is now required by Applicant's claim 11.

Turning to the remainder of claim 11, Applicant asserts that Al-Hussein's equipment 20 does not perform the various actions described in claim 11. For example, Al-Hussein's equipment 20 does not "access" form imaging data from at least one store, "retrieve" the form imaging data from the store, or "print" that data. Again, given that Al-Hussein's equipment 20 is essentially a facsimile machine, the equipment does not access or retrieve data and then print it. Instead, Al-Hussein's equipment 20 simply scans hard copy documents or receives fax transmissions. This fact is supported by Al-Hussein's discussions of accessing, retrieving, and printing provided in column 6:

By virtue of this arrangement, operators at one of the workstations 40 can scan in a document using PICS equipment 20, segmentation-process and recognition-process the document image so as to obtain a text file corresponding to text areas of the document, store the document image and associated text file on network disk 42, retrieve the document image and its associated text file for manipulation, if desired, at workstation 40, and print out the original or manipulated document image and text file on one of printers 45. . . .

Thus, for example, it is possible for one of workstations 57 to access the imaging capabilities of PICS equipment 20 via backbone 50 and modem

transponder 49; likewise, it is possible for one of workstations 51 to retrieve a document image from network disk 42, subject it to segmentation and recognition processing on PICS equipment 20, receive and manipulate the results at workstation 51, and print out documentation on one of printers 56.

*Al-Hussein*, column 6, lines 16-25 and 45-53.

As can be appreciated from the above excerpt, Al-Hussein's equipment 20 is used to scan a document as a conventional facsimile machine. The only "accessing" and "retrieving" of data in Al-Hussein's system, however, is performed by the workstations 40, *not* the equipment 20. Furthermore, the "printing" is only described as being performed by printers 45 and 56, and *not* by equipment 20. For at least those reasons, the basic premise of the rejection is false.

Applicant further submits that it would not have been obvious to provide the functionality of Lo's printer to Al-Hussein's equipment 20 given that, as described above, Al-Hussein's equipment is a facsimile machine and not a printer. Specifically, the functionalities performed by dedicated facsimile machines are different from those provided by printers and a person having ordinary skill in the art would not think to attribute printer functionalities (like printing forms from print ready data received from a PC) to Al-Hussein's equipment 20 when Al-Hussein so clearly is describing a dedicated facsimile machine and explicitly chose to include separate printers in his system to provide printing functionality.

In view of the above, Applicant submits that claim 11 and its dependents are allowable over Al-Hussein and Lo.

**b. Claims 19, 24, and 25**

Regarding independent claim 19, Applicant notes that neither Al-Hussein nor Lo teach or suggest “means provided on the printer for accessing form imaging data from at least one store via a network” or “means provided on the printer for retrieving the form imaging data from the at least one store” for reasons described above. Furthermore, there would have been no motivation to a person having ordinary skill in the art to add Lo’s form processing and printing functionalities to Al-Hussein’s equipment 20. Accordingly, claim 19 is allowable over Al-Hussein and Lo.

Regarding independent claim 24, Applicant notes that neither Al-Hussein nor Lo teach or suggest a “printer” comprising “logic configured to access form imaging data from at least one store via a network, retrieve the form imaging data, merge the received data with static form data already stored on printer to generate a completed form, and print the form imaging data along with the already stored static form data together as a hard copy form” for reasons described in the foregoing. Accordingly, claims 24 and 25 are allowable over Al-Hussein and Lo.

**B. Rejection of Claims 14, 16-18, 20-23, 26, and 27**

Claims 14, 16-18, 20-23, 26, and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein, Lo, LeClair et al.* (LeClair,” U.S. Pat. No. 6,636,891), and *Pennell et al.* (“Pennell,” U.S. Pat. No. 6,910,179). Applicant respectfully traverses this rejection.

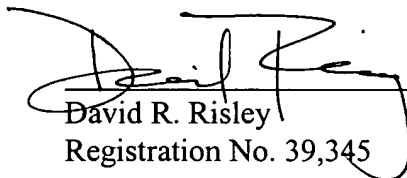
As is identified above, Al-Hussein and Lo do not teach several aspects of Applicant’s independent claims 11, 19, and 24. In that the LeClair and Pennell references

do not remedy the deficiencies of the Al-Hussein and Yuasa references, Applicant respectfully submits that claims 14, 16-18, 20-23, 26, and 27 are allowable over the Al-Hussein/Lo/LeClair/Pennell combination for at least the same reasons that claims 11, 19, and 24 are allowable over Al-Hussein/Lo.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

8-14-06  
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Signature